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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/844,716	04/25/2001	Carol S. Gruchala	8285/430	1846

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EXAMINER

BUI, BING Q

ART UNIT	PAPER NUMBER
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2642

DATE MAILED: 09/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

14

# Office Action Summary

Application No.  
09/844,716

Applicant(s)  
Grachula et al

Examiner  
Bing Bui

Art Unit  
2642



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jul 3, 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 27-59 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 27-59 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

The claimed invention in the instant application is fully disclosed in the patent and it is broader than the claimed invention in the patent number 6,252,953. No new

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invention, or new improvement is being claimed in the instant application. Applicant is now attempting to claim broadly that which had been previously described in more detail in the claims of the patent (In re Van Ornum, 214 USPQ 761 CCPA 1982).

Furthermore, there is no apparent reason why Applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent.

Claims 27-59 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-28 of U. S. Patent No. 6,252,953 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent. Although the conflicting claims are not identical, they are not patentably distinct from each other because the context of the claimed invention is similar to the context of the cited claim of the U.S. patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: a system and method for automatically modifying the calling party identification number to an identification number of a group associated with the calling party.

Claims 27, 33, 29, 32, 37-42, 44-45, 52-54, 56 and 58-59 of instant application substantially correspond to claims 1 and 14 of recited US Patent; claims 28, 30 and 46-49 of instant application substantially correspond to claims 7 and 8 of recited US

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Patent; claim 31 of instant application substantially corresponds to claims 13 and 26 of recited US Patent; claims 36 and 57 of instant application substantially corresponds to claims 12 and 25 of recited US Patent.

***Claim Rejections - 35 USC § 102***

3. Claims 27-33, 36-42, 44-49, 52-54 and 56-59 are rejected under 35 U.S.C. 102(e) as being anticipated by Shaffer et al (US Pat No. 6,130,935).

**Regarding claim 27**, Shaffer et al teach the invention as claimed, a method of providing a work-at-home telecommunication service, the method comprising:

(a) receiving a dialed number from a calling party, said calling party being associated with a calling party identification number (col 1, ln 57-col 2, ln 6).

(b) automatically modifying the calling party identification number to an identification

number of a group associated with the calling party (col 1, ln 57-col 2, ln 6 and col 4, ln 28-41).

**Regarding claim 28**, Shaffer et al teach the invention as claimed, the method further comprising the step of receiving a service specific code from the calling party (col 3, ln 8-38).

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**Regarding claim 29**, Shaffer et al teach the invention as claimed, the method further comprising the step of receiving a vertical service code from the calling party (col 3, ln 8-38).

**Regarding claim 30**, Shaffer et al teach the invention as claimed, the method further comprising the step of receiving an access code from the calling party (col 3, ln 8-38).

**Regarding claim 31**, Shaffer et al teach the invention as claimed, the method further comprising the step of receiving a personal identification number from the calling party (col 1, ln 57-col 2, ln 6).

**Regarding claim 32**, Shaffer et al teach the invention as claimed, wherein step (b) further comprises the step of sending a query to a service control point, the query comprising the calling party identification number (col 3, ln 39-61).

**Claims 33, 40-42 and 52-54**, they are rejected for the same reasons as recited in the rejection of claim 27.

**Regarding claims 36 and 57**, Shaffer et al teach the invention as claimed, wherein the dialed number comprises a private virtual network number (col 3, ln 24-38).

**Regarding claims 37 and 56**, Shaffer et al teach the invention as claimed, the method of further comprising the step of translating the dialed number to a called party identification number (col 1, ln 57-col 2, ln 6 and col 4, ln 42-65).

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**Regarding claim 38**, Shaffer et al teach the invention as claimed, the method of further comprising the step of determining a telecommunication carrier for the group associated with the calling party (col 3, ln 24-61).

**Claims 39 and 58-59**, they are rejected for the same reasons as recited in the rejection of claim 38.

**Regarding claims 44-45**, there is provided by Shaffer et al a system which comprises appropriate means for carrying out the method according to claim 27.

**Claims 46-49**, they are rejected for the same reasons as recited in the rejection of claim 28.

***Claim Rejections - 35 U.S.C. § 103***

4. Claims 34-35, 43, 50-51 and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer et al '935 as applied in claim 27, and further in view of London (US Pat No. 5,590,184).

**Regarding claims 34 and 50**, Shaffer et al teach the invention substantially as claimed, with the exception of providing the step of sending the modified calling party identification number to a called party associated with the dialed number. However, it is obvious that Shaffer et al suggest the modified number is a number of a group that translated (modified) from a work-at-home agent's station number (col 1, ln 57-col 2, ln 6 and col 4, ln 28-41). London teaches a number modified from caller identification

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number to be sent to a caller-id display unit associated with a called party (Abstract and col 3, ln 8-42).

Therefore, it would have been obvious to one skilled in the art to use the Caller-ID service as taught by London that enables the work-at-home system of Shaffer et al to send the identification of business group in place of the agent's identification to a recipient called party.

**Regarding claims 35 and 51**, Shaffer et al teach the invention substantially as claimed, with the exception of providing the step of sending the modified calling party identification number to a called party associated with the dialed number in response to a failure of receiving a privacy access code from the calling party . However, it is obvious that Shaffer et al suggest that in response to a call made to a non-virtual network called party, the only ANI associated with a work-at-home agent is translated (modified) into a number of a group and this translated (modified) number is sent along with non-virtual network called party number to an IEC that routes the call to the recipient called party (col 3, ln 39-61). London teaches a number modified from caller identification number is sent to caller-id display unit associated with called party (Abstract and col 3, ln 8-42).

Therefore, it would have been obvious to one skilled in the art to use the Caller-ID service as taught by London that enables the work-at-home system of Shaffer et al



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to send the identification of business group in place of the agent's identification to a recipient called party.

**Claims 43 and 55**, they are rejected for the same reasons as recited in the rejection of claim 34.

### ***Response to Arguments***

5. Applicant's arguments with respect to claims 27, 44 and 45 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Dougherty et al (US Pat No. 5,689,799) disclose a system and method for routing confidential information.

Ikeda (US Pat No. 5,475,744) discloses a system and method for adding a calling station ID number to the call signal.

Bellcore (TR-TSY-000031) discloses a system in which a caller may enter four digits or longer PIN which is transmitted to a called party's CPE to be displayed instead of the calling directory number.

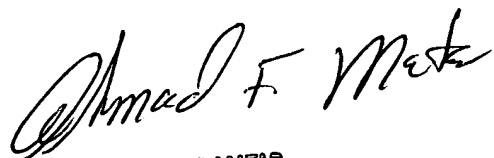
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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bing Bui whose telephone number is (703) 308-5858. The examiner can normally be reached on Monday through Thursday from 7:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on (703) 305-4731. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314 and for formal communications intended for entry (please label the response "EXPEDITED PROCEDURE") or for informal or draft communications not intended for entry (please label the response "PROPOSED" or "DRAFT").

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

Bing Bui  
Sep 11 , 2002

  
AHMAD F. MATAR  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2700